

**SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM**

DATE: 11-13-97

APPL. S.N.: 081 468 161

TO EXAMINER: S. Marshall

ART UNIT: 1811

M. Montgomery ROOM 6E18

MAILROOM DATE 11-5-97

AFTER FINAL YES ☒ NO ☐ NUMBER OF T.D(S). FILED 1

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

☐ Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

**FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:**

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

**MERCK & CO., INC.**  
Patent Department  
PO Box 2000 - RY 60-30  
Rahway, New Jersey USA 07065-0907  
Facsimile Tel. No. (732) 594-4720

#11  
Terminal  
D. Schaefer  
11/5/97

**FACSIMILE TRANSMISSION**

To the Assistant Commissioner for Patents  
Washington, D.C. 20231

Date of Transmission: November 5, 1997

**Please deliver this facsimile to:**

Facsimile No.: (703) 308-8724  
Examiner: Sandra Marshall  
Group Number: 1811

**This facsimile is from:**

Name: David A. Muthard  
Location: Merck & Co., Inc., Patent Department  
Rahway, New Jersey USA 07065-0907  
Telephone Number: (732) 594-3903

**This facsimile is in regard to:**

Applicants: D. DeFeo-Jones, et al.  
Serial Number: 08/468,161 Case No.: 192531B  
Filing Date: June 6, 1995  
Title: NOVEL PEPTIDES

Number of pages being transmitted, including cover: Thirteen (13)  
(If in duplicate:     ) (If in triplicate: X)

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being transmitted by facsimile to the Patent and  
Trademark Office on the date shown below:

  
David A. Muthard Date: November 5, 1997

**IF THERE IS A PROBLEM WITH THIS TRANSMISSION,**  
**PLEASE CONTACT GERRY EMERICK - (732) 594-6384**

## PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Deborah Defeo-Jones, Dong-Mei Feng,  
Victor M. Garsky, Raymond E. Jones and  
Allen I. Oliff

Serial No. 08/468,161 (Case No. 19253IB) Group No.: 1811  
Filed: June 6, 1995 Examiner: S. Marshall  
For: NOVEL PEPTIDES

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION  
(37 CFR 1.321(b))

## Identification of Person(s) Making This Disclaimer

Name(s) of disclaimant(s) Mark R. Daniel  
Residing at 64 Willis Drive, Ewing, New Jersey 08628

represent that I am

- ☐ an inventor of this invention  
☐ an assignee of this invention  
☒ a representative authorized to sign on behalf of the assignee identified below.

## Identity of Assignee and Title of Disclaimant (if applicable)

The assignee is

Name of assignee Merck & Co., Inc.  
Address of assignee 126 E. Lincoln Avenue, P.O. Box 2000  
Rahway, New Jersey 07065-0907  
Title of disclaimant Patent Counsel  
authorized to sign on behalf of assignee

## Recordal of Assignment in PTO

- ☒ the assignment was submitted for recordation on 10/24/97  
Reel Not Yet Known  
Frame Not Yet Known  
☐ authorization for recordal of the assignment is separately attached

## Extent of Interest

The extent of my(our) interest is in

- ☒ the whole of this invention  
☐ a sectional interest in this invention as follows (here state the exact interest of the disclaimant(s):

Serial No. 08/468,161

Case No. 19253IB

Page 2

**Disclaimer**

I hereby disclaim the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of:

☐ United States Patent No. \_\_\_\_\_, as presently shortened by any terminal disclaimer

☒ Any patents granted on application number(s) 08/540,412,

and hereby agree that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to

☐ United States Patent No. \_\_\_\_\_

☒ Any patents granted on application number(s) 08/540,412

this agreement to run with any patent granted on the above-identified application and to be binding upon the grantor, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of

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in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

**Fee Status**

(37 CFR 1.20(d) and 37 CFR 1.321)

☒ other than a small entity--fee \$110.00

☐ small entity--fee \$55.00

☐ verified statement attached

☐ verified statement filed on \_\_\_\_\_

**Fee Payment**

☐ Attached is a check in the sum of \$ \_\_\_\_\_.

☒ Charge Account 13-2755 the sum of \$ 110.00. A triplicate of this disclaimer is attached.



Signature(s) of Disclaimant(s)

Mark R. Daniel

Page 1 of 1  
Amended 4/23/97

# **General Corporate Resolution #5**

## **PATENT MATTERS**

RESOLVED, that any of the following:

Raymond V. Gilmartin-Chairman of the Board, President and Chief Executive Officer  
Mary M. McDonald-Senior Vice President and General Counsel  
Joseph F. DiPrima-Vice President and Assistant General Counsel  
Paul D. Matukaitis-Vice President and Assistant General Counsel  
Edward Murray-Counsel, Litigation  
Charles M. Caruso-Counsel, International  
W. Gwyn Cole-Senior Director-European Patents  
Mark R. Daniel-Counsel, Patents  
David L. Rose-Counsel, Patents  
Jack L. Tribble-Counsel, Patents  
Melvin Winokur-Counsel, Patents  
Donna L. Pollock-Administrator, Patents

are authorized to execute and to revoke on behalf of Merck & Co., Inc. and its affiliates (including subsidiaries) the following documents relating to patent matters:

Powers of attorney as fully in law as may be necessary and proper in connection with the acquisition, registration, maintenance and enforcement of patents and applications for patents, including powers of attorney relating to the prosecution or defense of patent rights before courts of law or other governmental tribunals, agencies or departments; affidavits and declarations; and any other documents which are necessary and proper for the acquisition, registration, maintenance, litigation and protection of patents.

CERTIFICATION

I, DOLORES O. ROSINSKI, Senior Assistant Secretary of Merck & Co., Inc., a Corporation duly organized and existing under the laws of the State of New Jersey, do hereby certify that the attached, presently in full force and effect, is a true and correct copy of General Corporate Resolution #5, Patent Matters, as amended on April 23, 1997 by the Board of Directors of said Corporation at a meeting thereof duly called and held on April 23, 1997 at which a quorum was present.

IN WITNESS WHEREOF, I have hereunto subscribed my signature and affixed the seal of the Corporation this 5th day of June, 1997.

  
Senior Assistant Secretary

SEAL

00103-20

## PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Deborah Defeo-Jones, Dong-Mei Feng,  
Victor M. Garsky, Raymond E. Jones and  
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Serial No. 08/468,161 (Case No. 19253IB)  
Filed: June 6, 1995  
For: NOVEL PEPTIDES

Group No.: 1811  
Examiner: S. Marshall

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION  
(37 CFR 1.321(b))

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Name(s) of disclaimant(s) Mark R. Daniel  
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represent that I am

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The assignee is

Name of assignee Merck & Co., Inc.  
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Serial No. 08/468,161  
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Page 2

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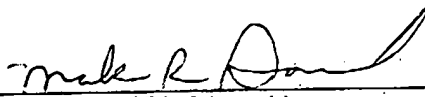
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Amended 4/23/97

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Senior Assistant Secretary

SEAL

00103-20

TOTAL P.013